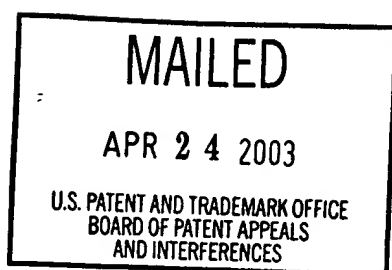


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte PAUL C. ZIMMER

Appeal No. 2003-0250
Application No. 09/612,821

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a promotional calendar (claims 1-3) and a method of promoting an enterprise to selected individuals (claims 4 and 5). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hallam	964,967	July 19, 1910
Deaton	1,427,786	Sept. 5, 1922

Claims 1 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hallam in view of Deaton.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 9, mailed July 24, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 8, filed July 8, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we will not sustain the rejection of claims 1 to 5 under 35 U.S.C. § 103 for the reasons which follow.

In the rejection before us in this appeal (answer, p. 3), the examiner

- (1) determined that Hallam taught a promotional calendar comprising a series of pages each imprinted with a respective day of the year and held together to allow turning or tear off of each page (at 3), each page printed with an identifier of an enterprise to be promoted (at 7B);
- (2) determined that Deaton taught a promotional calendar that is personalized with an individual's name (at 15);
- (3) ascertained that Hallam did not teach that each page is prominently printed with the name of a person to personalize the calendar; and
- (4) found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a personalization on the calendar of Hallam in view of the teachings of Deaton as it is a well known marketing technique to facilitate a relationship with customers by including a personalization on a promotional gift.

The appellant argues (brief, pp. 4-5) that the prior art as applied in the rejection under appeal does not make obvious the claimed subject matter. We agree. In that regard, the claimed subject matter requires that each page of a daily calendar be prominently printed with the name of a person to personalize the calendar. The examiner ascertained that Hallam did not teach that each page is prominently printed with the name of a person to personalize the calendar; However, the examiner did not find that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the daily calendar of Hallam so that each page of the daily calendar be prominently printed with the name of a person to personalize the calendar. Thus, the examiner did not determine that the claimed subject matter would have been obvious under 35 U.S.C. § 103. Moreover, it is our view that the teachings of Deaton would have made it obvious to one of ordinary skill in the art at the time the invention was made to have included a personalization such as the name of the person to whom the calendar is presented and the name of the donor on only the permanent part of the calendar of Hallam (i.e., the portion of Hallam's calendar book 2 above line 3 depicted in Figure 1) and not on each of a plurality of pages as recited in the claims under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner for consideration of the following matters.

(1) Whether the printed indicia recited in the claims on appeal is "printed matter" and, if so, whether or not it is functionally related to the substrate in a new and unobvious way so as to distinguish over the prior art in terms of patentability. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). See also MPEP § 2106 (Eighth Edition, Revision 1, Feb. 2003) which in the section entitled "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 102 AND 103" (pp. 2100-21 and 2100-22) provides that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.¹

(2) Whether further consideration of the patentability of any of the appealed claims is justified in light of (1).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

¹ See also FORMULATING AND COMMUNICATING REJECTIONS UNDER 35 U.S.C. 103 FOR APPLICATIONS DIRECTED TO COMPUTER-IMPLEMENTED BUSINESS METHOD INVENTIONS, Example 12 (Rationale reasoned from the difference is the data being stored (article of manufacture)), available at <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#E12>.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REVERSED; REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

John P. McQuade

JOHN P. McQUADE
Administrative Patent Judge

Jeffrey V. Nase

JEFFREY V. NASE
Administrative Patent Judge

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